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In The

# Supreme Court of the United States

FESTO CORPORATION,

*Petitioner,*

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD.,
a/k/a SMC CORPORATION AND
SMC PNEUMATICS, INC.,

*Respondents.*

**On Writ Of Certiorari**
**To The United States Court Of Appeals**
**For The Federal Circuit**

## BRIEF OF AMICI CURIAE APPLERA CORPORATION (APPLIED BIOSYSTEMS AND CELERA GENOMICS), APPLIED MATERIALS, INC., CISCO SYSTEMS, INC., MICRON TECHNOLOGY, INC., AND ORACLE CORPORATION IN SUPPORT OF RESPONDENTS

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## I.

## STATEMENT OF INTEREST

This brief is submitted by Applera Corporation (including Applied Biosystems and Celera Genomics), Applied Materials, Inc., Cisco Systems, Inc., Micron Technology, Inc., and Oracle Corporation (referred to collectively as "Amici").[1]

Amici are companies whose technological contributions epitomize the innovation that the Constitutional mandate for a patent system is intended to promote. Indeed, Amici's technological developments have led to: (1) important patents that have been recognized by courts, competitors, and consumers as protecting major advances that have both enabled and fueled a technological revolution, and (2) the wide-spread acceptance of their technology-based products to the point where such products have become staples of the global economy.[2] Amici are also active in asserting *and* defending against numerous patent infringement claims, and thus cannot be categorized as generally plaintiffs or generally defendants in patent infringement cases.

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[1] Pursuant to Rule 37.6, none of the parties or their counsel has contributed substantively or monetarily to the preparation of this brief. Specifically, only Amici and their counsel have contributed to the preparation or submission of this brief. The consents of the parties are being lodged herewith.

[2] For example, Applied Biosystems' DNA sequencing products, Applied Materials' semiconductor chip making equipment, Celera's genomic information, Cisco's internet equipment, Micron's computer memory chips, and Oracle's database software are each acknowledged as the gold standard in their respective fields.

These qualities place Amici in a balanced position to advise the Court concerning the Questions Presented. Specifically, the future of each of the Amici is dependent on a balance between the effective protection of its technology through a robust patent system and the ability to evaluate the patent landscape with sufficient clarity to permit continued innovation and to minimize the cost of litigation encouraged by uncertainty. This duality forces Amici to approach the Questions Presented with balance, and does not allow them to adopt one position or the other in patent cases based simply on whether a position is pro-plaintiff or pro-defendant.

Amici undertake this joint brief because they believe their shared viewpoint adds a unique perspective. The amicus briefs submitted thus far are sponsored by entities that generally have a one-sided interest in the potency of patents – but that have little reason to be concerned about excesses inflicted if the system instills too much power in the threat of patent assertions. The university licensing amici benefit from an increase in the threat posed by patents, but have no fear of excesses because they rarely if ever make or sell products themselves. Individual inventors have a one-sided interest in the strength of patents for the same reason.[3]

Similarly, the views on the Questions Presented set forth by interest groups representing attorneys must be

[3] Other amici are companies that are uniquely built on narrow products that are heavily patented, or are companies whose patent litigation and licensing efforts outshine their success with technology-based products. These companies also have a relatively untempered motivation to strengthen patents.



evaluated with a recognition of the personal benefit many members of such groups obtain from the addition of more legal tests and analyses in patent law and from litigation-inducing uncertainty. In addition, such groups would benefit from the expanded toleration of professional inexactness, or even sloppiness, that is in some ways the chief argument for the elimination of the certainty-advancing rules set forth by the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) ("*Festo*"). That these groups attempt to overturn the *Festo* decision is understandable – but appears to stem from the one-sided nature of their interest in the patent system.

There are two additional voices before the Court which come from a balanced perspective: the United States and the Institute Of Electrical and Electronics Engineers (I.E.E.E.). As described further below, Amici agree with much contained in the briefs of those entities, but with important points of difference that are set forth below.

In sum, Amici do not have a general interest that is either for or against the power of patents or for or against plaintiffs or defendants. Rather, Amici, much like the Constitutional founders and this Court, are interested in balancing a robust patent system to protect the development of technology with clear rules that minimize conflict, litigation, and uncertainty, and therefore encourage innovation. Accordingly, Amici are hopeful that their views will aid the Court in its resolution of the Questions Presented.

## II.

## INTRODUCTION

The essence of the argument against the Federal Circuit's decision in *Festo* is that the Federal Circuit supposedly inflicted a "crippling blow" to the patent system. Pet. Brief at 42. According to Petitioner and supporting amici, if this Court affirms that ruling "investment in patentable inventions will sharply and very substantially decline." *Id.*

Amici submit this brief to report to this Court that the "sky above the patent landscape" is *not* falling. Amici have many important products whose sales are protected by patents. Indeed, without meaningful patent protection, Amici's industry leading products could be copied or mimicked by the many competitors chasing them. Yet, Amici are confident that the patent system will be strengthened by clear ground rules that enhance respect for valid patent rights and provide innovators with added clarity as to the boundaries of patent rights. Amici are also confident that the *Festo* rule will not facilitate the misappropriation of patented technology. Indeed, Amici have not reduced investment in technology or patent applications because of *Festo*, and would have *more* confidence in the wisdom of continuing to innovate if this Court affirms *Festo*. As set forth in greater detail below, Petitioner's speculation about the dire effect of affirming *Festo* simply does not withstand scrutiny.[4]

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[4] Many of the critics of *Festo* make arguments reflecting parochial interests. In some instances, claims are made that particular types of technologies or particular products are special and will be disparately affected by *Festo*. Amici believe that *Festo* sets forth neutral principles equally applicable to all technologies and products, and thus should be evaluated based upon its overall impact on the technology community and the public interest.



The *Festo* rule recognizes that, when the Patent Office rejects proposed claims and an applicant makes changes to the particular claim language at the point of disputed patentability,[5] it is the obligation of the applicant to *claim* the scope of coverage to which it believes it is entitled. This is common sense. Simply put, when both the resources of the applicant and the resources of the Patent Office are directly focused on setting the permissible boundary of coverage at the precise point of disputed patentability, they should resolve the issue by determining that line clearly and carefully at that time. There should not be room in the system to allow narrow language to be added to gain allowance of the patent with the belief that disputes can be deferred until litigation about the proper scope of the claim at the point of disputed patentability.

Amici United States and I.E.E.E. correctly acknowledge this straightforward logic. U.S. Brief at 26 ("The courts can properly insist that prosecution history estoppel requires applicants to draft claim amendments to encompass literally all the equivalents they wish to include."); I.E.E.E. Brief at 23 ("Where the limiting effect

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[5] The "point of disputed patentability" refers to the portion of the claimed subject matter where a narrowing amendment is made to avoid a Patent Office rejection. This includes amendments made for existing rejections as well as anticipated rejections expressly preempted by an applicant.

of an amendment's language with respect to an accused device should have been foreseen by a person reasonably skilled in the art, the patentee should not be permitted to ignore that effect by utilizing the doctrine of equivalents . . . "). However, these amici further argue that, where an applicant could not have foreseen at the time of its narrowing claim amendment how to draft claim language that would have covered the accused product, an absolute bar rule preventing reliance on the doctrine of equivalents may be "unfair." Accordingly, they argue that this fairness concern outweighs the significant cost in uncertainty of providing "fudge" room to the applicant during subsequent litigation. Thus, these amici propose a narrow foreseeability exception to the *Festo* rule.[6]

As explained further below, there are relatively few situations in which proper claim drafting could not have covered an accused device due to the unforeseeability of the claim language. On balance, the cost of requiring a foreseeability analysis (which could turn into a trial within a trial) in nearly every case involving prosecution history estoppel is not justified by those few situations. Indeed, allowing such an exception to the *Festo* rule would impose on all the considerable expense of litigating the foreseeability issue (which would most likely require the consideration of substantial evidence, and the

[6] As explained further below at pages 23-25, the contours of the proposed "foreseeability" exception, as it would be implemented in practice, are not particularly clear. Amici understand it to refer to the foreseeability of claim language that would be sufficiently broad to cover a feature of an accused product that is not literally encompassed by the chosen claim language.



resolution of potentially nebulous factual disputes) as patent holders attempt to keep doctrine of equivalents claims alive. Simply put, there are enough tests and subtests in patent litigation as it stands. However, a narrow foreseeability exception to the *Festo* rule, applicable in only limited circumstances where claim language to cover a major technological development is truly unforeseeable, would be superior to the flexible bar rule. The flexible bar rule is intolerable because it allows those who *could* have foreseeably selected appropriate claim language to avoid Patent Office scrutiny on a disputed issue of patentability by merely waiting until the litigation process before seeking to notify the public of the claimed scope of their property right.

## III.

## THE FEDERAL CIRCUIT'S *FESTO* RULING SHOULD BE AFFIRMED

Amici agree with the United States' neutral statement of the two Questions Presented. First, Amici address Petitioner's request that this Court adopt the so-called "flexible bar" rule. Second, Amici address Petitioner's request that this Court hold that some types of narrowing amendments made for reasons of patentability should be unlimited by the doctrine of prosecution history estoppel.

### A. The Flexible Bar Rule Should Not Be Adopted By This Court

In *Festo*, the Federal Circuit ruled that patentees should be bound to the claim language they specifically

add during prosecution at the point of disputed patentability, reasoning that the flexible bar rule is unworkable. The first section below establishes that a patentee should not be permitted to obtain claim scope through the doctrine of equivalents that is broader in scope than the plain language it added at the point of disputed patentability, but which it could have foreseeably attempted to include in the claims if it had believed that it was entitled to broader claim coverage.[7] The second section establishes that the circumstances in which a feature of an accused product could not have foreseeably been included within the claim amendment are so infrequent that the burden imposed by requiring this evidentiary issue to be yet another issue litigated in every case involving prosecution history estoppel is unjustified.

### 1. Use Of The Doctrine Of Equivalents To Ensnare Claim Scope Beyond The Narrowing Language The Applicant Selected At The Point Of Disputed Patentability Should Not Be Permitted

In *Festo*, the Federal Circuit explained in detail that, if an applicant narrows its patent claims to avoid a patentability rejection, the applicant should not be able to defer until litigation a clear decision about the extent to which it can gain coverage outside the specific language it selected at the point of disputed patentability. *See Festo*, 234 F.3d at 576-77. As common sense dictates, if broader

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[7] Of course, whether the Patent Office would have granted the foreseeable and broader claim scope is an issue that the applicant unfairly side-steps, if the Petitioner's analysis is accepted.



claim language were in fact foreseeable and the applicant for some reason elected *not* to seek such claim scope at the point in the Patent Office process when the applicant and the examiner were focused on the limits of patentability, a rule permitting arguments for expanded claim scope later should be barred.

Those attacking the Federal Circuit's sound rule set forth a series of arguments, including some that are superficially seductive and thus demand a response. They are addressed in turn.

#### a. The "Supreme Court Precedent" Argument Does Not Justify Overturning The Federal Circuit's Ruling

Petitioner contends that the Federal Circuit's ruling is improper because the "spirit" of this Court's precedent mandates the flexible bar rule. Pet. Brief at 33.

This argument must be rejected because it disregards this Court's most relevant analysis, and the leading case on the question of prosecution history estoppel. In *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942), Chief Justice Stone concluded that an amendment constitutes a disclaimer of *all* the subject matter outside a limitation added at the point of disputed patentability: "By the amendment he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of *all* that is embraced in that difference." (emphasis supplied) (citations omitted).

In the face of *Exhibit Supply*, and without addressing it, Petitioner chiefly relies upon four cases from the late

1800s. However, all of the patent claims involved in those cases state that they include within their literal scope "equivalents" of the described subject matter and/or "substantially" what is described. *Hurlbut v. Schillinger*, 130 U.S. 456, 463 (1889) (quoting U.S. Patent No. RE 4,364); *Shepard v. Carrigan*, 116 U.S. 593, 594 (1886) (quoting patent at issue); *Fay v. Cordesman*, 109 U.S. 408, 413-14 (1883) (quoting U.S. Patent No. RE 1,527); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 223 (1880) (quoting U.S. Patent No. RE 1,904). Thus, such cases are better viewed as literal infringement cases under the very different claiming conventions of that era. This is important because these applicants were expressly *claiming* that they were entitled to more than the terms of the specific language of the amendment – even in the face of a patentability challenge. Of course, this Court acted logically in those cases to the extent it concluded that the applicants did not *disclaim* claim scope that they were in fact specifically *claiming*.

### b. The "Actual Surrender" Argument Does Not Justify The Flexible Bar Rule

Those attacking the *Festo* rule argue at great length that the Federal Circuit ignored the general principle that an estoppel should apply only to the subject matter that is actually surrendered. *See, e.g.*, A.I.P.L.A. Brief at 7 ("A clear and unmistakable surrender of otherwise patentable subject matter should be the touchstone of prosecution history estoppel . . . "). These critics insist that what is surrendered is not determined by the perimeter of the language selected by the applicant to delineate its right,



but will instead often lie somewhere in the zone between the impermissibly broad original limitation and the narrowing language added by the applicant. *See, e.g., id.* However, this argument is unhelpful because it assumes its conclusion. Specifically, it assumes that the applicant's selection of claim language to define the scope of its patent right at the point of disputed patentability is somehow the *wrong* line of demarcation as to what is surrendered, without adding substantive content as to why it would be improper.

Not only is this argument unhelpful, it is wrong. As noted above, as long ago as *Exhibit Supply*, this Court determined that the applicant's selection of particular narrowing language to avoid a patentability rejection constitutes the proclamation that "all that is embraced" in the difference between the original language and the amended language is abandoned. *Exhibit Supply*, 315 U.S. at 136. Where the applicant has made a choice not to expose a request for greater claim scope to the Patent Office for examination, and therefore is properly understood not to be claiming such subject matter, it is fair to conclude that such subject matter is surrendered, as set forth in *Festo*. The suggestion that the "true surrender" created by an amendment is in an undefined zone best determined in litigation after Patent Office examination ignores the fact that a surrender occurs at the time of the amendment giving rise to the estoppel. As such, the scope of surrender caused by an amendment is best measured at the time it could be changed by the applicant and before it becomes an effective patent right that can be wielded in litigation. In addition, deferring a decision about the extent of surrender seriously undermines the

notice function of patent claiming. Finally, the cost of any uncertainty about the scope of a surrender should be borne by the party creating it (the applicant that sought less claim coverage than it later asserted it was entitled to seek), rather than the public as a whole.

In short, the most accurate and effective measure of what the applicant has surrendered *is* the specific language selected by it at the specific point of disputed patentability. The Federal Circuit recognized and relied upon this reality. Its ruling should not be disrupted.

### c. Far From Being "Straightforward," The Flexible Bar Rule Creates Ambiguity And Uncertainty

Based on its day-in and day-out responsibility for adjudicating patent cases, the Federal Circuit concluded that the flexible bar rule was difficult to apply and created unjust uncertainty. *See Festo*, 234 F.3d at 577. Some of those attacking the *Festo* rule insist the application of the flexible bar rule is straightforward. *See* Pet. Brief at 32-33; *but see* F.C.B.A. Brief at 11 ("While the flexible bar has not always been applied with ideal clarity or consistency . . . "). This claim is inconsistent with Amici's substantial experience and, moreover, is disproved by Petitioner's own example.

To attempt to prove that the flexible bar rule is straightforward to apply, Petitioner relies chiefly on the following example: A claim is narrowed from language that generically covers all attachments, to language that covers only "glue." This narrowing is provoked by prior art that discloses the use of a nail as an attachment. From



this hypothetical, Petitioner argues that the flexible rule is straightforward to apply because it should be obvious that a screw is so much like a nail that it would be clear that coverage of a screw would be estopped.

Even if it were clear that the flexible bar rule would permit the non-infringing use of a screw attachment in view of the "glue" attachment claim limitation – and Amici's litigation experiences give it no comfort on this score – Petitioner's own example highlights the magnitude of the uncertainty created by the flexible bar rule. There are obviously a vast number of different attachments, including tape, magnets, epoxy, suction cups, clips, hooks, Velcro, hinges, latches, staples, rivets, and welds. Trying to determine whether these attachments are more like "glue" (and thus not subject to estoppel according to Petitioner's analysis), or are more like a "nail" (and thus subject to an estoppel), vividly illustrates the uncertainty of the flexible bar rule and the lack of clear principles to guide one attempting to employ that rule. Is a weld closer to glue or a nail? Is tape close enough to glue because it uses adhesive? Is a magnet more like a nail because it is metal? How about Velcro?

Concern that something like a staple or rivet could be found to be an equivalent of glue is not speculative. Indeed, in *Al-Site Corp. v. VSI Int'l Corp.*, 174 F.3d 1308, 1316 (Fed. Cir. 1999), the Federal Circuit recently upheld a jury verdict that a glue, a rivet, and a staple are all structurally equivalent attachments.

The flexible bar rule is difficult, if not impossible, to apply in a principled way in most cases, as Petitioner's own example demonstrates, and as Amici's experience

confirms. In real cases where the technology is even more complicated than Petitioner's simple example, the difficulty of applying the flexible bar rule is compounded.

### d. *Festo* Will Not "Destroy" The Doctrine Of Equivalents

Those attacking the *Festo* rule use extreme hyperbole to argue that this rule essentially prevents the doctrine of equivalents from meaningfully protecting patent rights. *See, e.g.*, A.B.A. Brief at 2 ("the new rule all but abolishes the doctrine of equivalents for a large proportion of the more than 1.2 million unexpired patents"). There are several fallacies underlying this argument.

First, this argument ignores the fact that the *Festo* rule applies only to the particular words added to narrow the claim at the point of disputed patentability. Typically, this is only a small fraction of the claim. Accordingly, the doctrine of equivalents *is* in fact available with respect to most of the terms of patent claims that are narrowed for purposes of patentability. Most critics get this wrong, and incorrectly suggest that the doctrine of equivalents would be barred generally. *See, e.g.*, Pet. Brief at 2 ("the new principles announced by the Federal Circuit will effectively strip most existing patents of the vital protection provided by the doctrine of equivalents"). The limited nature of the *Festo* rule severely curtails any potential that it will generally preclude coverage of subject matter that would otherwise properly fall within the doctrine of equivalents.



Second, because the *Festo* rule only applies to narrowing language added at the point of disputed patentability, any doctrine of equivalents allegation barred by the *Festo* rule necessarily relates to a material limitation at the point of disputed patentability. This Court stressed in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co*, 520 U.S. 17, 40 (1997), that the doctrine of equivalents is a limited doctrine designed only to protect a patentee against insubstantial changes. As a matter of logic, insubstantial changes from the claimed subject matter would typically lie far from the point of patentability. Thus, the likelihood is not great that the difference between a new product and the narrowing claim language right at the point of disputed patentability would somehow be insubstantial.

Third, the suggestion that it is generally easy to make a trivial modification to a product to fall outside of an added claim limitation ignores the broad latitude that a patent applicant has to define its claims. For instance, in the example used by Petitioner, and referenced in the prior section at pages 12-13, above, if the applicant truly believed it was entitled to a broad attachment claim in the face of the "nail" prior art it could have simply claimed "attachments that are not nails." *See In re: Barr*, 444 F.2d 588, 595 (C.C.P.A. 1971) (holding that negative claims are permissible). This would have covered every attachment except a nail, assuming that the Patent Office agreed that such a broad claim was patentable. Likewise, the applicant could have sought several claims covering several attachment methods, or could have claimed a "liquid attachment" or a "chemical-based" attachment or "an attachment including at least one sticky surface." All of

these claims would likely have literally encompassed paste (the differentiating element of the product that the applicant would like to find infringing in the hypothetical), rather than narrowly limiting the claim only to "glue attachments" as the applicant hypothetically did. In addition, if the applicant believed the prior art with the nail attachment should not bar patentability because the particular nature of the attachment was unimportant to the novelty of the invention, it could have appealed and overcome the rejection if it were correct.

In sum, the suggestion that it is often easy to make trivial changes at the point of disputed patentability that allow one to steal inventions without falling within the literal scope of a patent claim is analytically incorrect, and inconsistent with Amici's experience generally.

### e. The Quality Of Patent Prosecution Will Not Be Reduced By *Festo*

Critics of the *Festo* rule contend that this rule somehow degrades patent prosecution. However, many of the changes predicted by the critics make patent examination more effective, not less.

Specifically, *Festo* critics predict that applicants who believe a rejection is unwarranted will now appeal, rather than simply narrowing the claim and accepting an estoppel. *See, e.g.*, Pet. Brief at 39 ("the number of appeals will increase dramatically"); A.I.P.L.A. Brief at 14 ("the effects of *Festo* on the USPTO would be generally negative, involving more rejections and more appeals"). A threshold problem with this analysis is that, even under Petitioner's rule, an estoppel would be accepted with such an



amendment, albeit uncertain in scope. In any event, improper rejections *should* be appealed. A healthy appellate process is obviously not something to avoid, particularly if it facilitates the issuance of a patent with claims that provide the applicant with the broadest coverage appropriate, while also providing the public with clear notice of what falls within the scope of the patent. Moreover, Petitioner's rule creates an unhealthy incentive for applicants to acquiesce in meritless rejections based on the hope that they can obtain a narrow patent easily and use the doctrine of equivalents to attempt to expand coverage as needed.

A second change in patent prosecution practice predicted by the critics is that applicants will not be as ambitious in the scope of the claims that they submit to the Patent Office, will be more likely to search for relevant prior art before submitting their claims to the Patent Office for examination, and will therefore submit narrower claims at the outset. *See, e.g.*, A.B.A. Brief at 19 ("Time-consuming and expensive pre-filing searches are more important now . . . ."); F.C.B.A. Brief at 9 ("Applicants may draft narrow claims that are likely to be allowed without amendment.").

Amici believe that any such change in practice would be quite positive. Unfortunately, too many applicants engage in the practice of submitting overbroad "Hail Mary" claims with the hope that an overworked Patent Office employee will allow such claims through the process without rejection. Moreover, if applicants were to search for prior art and refine the claims that they submit to the Patent Office in the first place, the process would obviously be more refined, more accurate, faster and, all

things considered, *less* expensive. In any event, any conceivable incremental increase in the cost of patent prosecution due to the *Festo* rule pales in comparison to the concomitant savings in product development or patent litigation. Importantly, none of these changes prevents applicants from aggressively pursuing the full breadth of coverage to which they believe they are entitled.

In sum, Amici believe that the predicted changes, assuming they occur, will *improve* patent prosecution.

### f. The Suggestions That The *Festo* Rule Helps Large Entities More Than Small Entities Is Unsupported

Some critics of the *Festo* rule imply that it helps large entities more than small entities. F.C.B.A. Brief at 9-10. This is not, in fact, the case.

First, a major benefit of the *Festo* rule, by any measure, is that the patent landscape is much clearer for those seeking to innovate. Because both large and small entities innovate, they both benefit.

Second, some critics suggest that the *Festo* rule makes patent prosecution costly. *Id.* However, clearly the most important impact of the *Festo* rule to prosecution is the importance of the selection of claim language added at the point of disputed patentability. Once an applicant facing a patentability rejection prepares a response including a proposed amendment, and has analyzed the basis for a potential rejection, the cost of preparing an amendment is already entirely incurred. At that point, the amount of time or expense it takes to select particular



words, over other potential words, for the amendment obviously is not large. For this reason, selecting the proper language is not really a question of dollars and cents. Indeed, encouraging patent attorneys to select the proper claim language at the point of disputed patentability is best achieved by emphasizing to them through legal rules that they cannot be sloppy when selecting language with the expectation that any "missed," but patentable, subject matter can be reclaimed later through litigation.

Finally, small entities would benefit from a system that reduces uncertainty and the expensive litigation encouraged by such uncertainty. As noted above, the cost of litigation spawned by uncertainty greatly exceeds any marginal increase in the cost of prosecution (if it does not in fact *decrease*) that could be expected under the *Festo* rule. Because smaller entities generally have fewer resources to address the expense of litigation, *Festo*'s certainty-advancing rule would work to the benefit, not detriment, of small entities.[8]

In any event, whether the patent owner is large or small, the effect of a rule that tolerates the sloppy selection of claim language at the point of disputed patentability is too costly for this Court to adopt.

### g. *Festo* Does Not Eliminate Any Vested Rights

Critics of *Festo* contend that it somehow eliminates vested rights. Specifically, critics contend that applicants

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[8] This is most true for small companies that are not patent litigation savvy or experienced, and whose voice this Court ironically will not hear in this proceeding for that very reason.

narrowing their claims at the point of disputed patentability to obtain patent rights had a vested interest that cannot legally be taken away in subject matter *beyond* what they claimed as the scope of their right. *See generally* Litton Systems Brief. Even if *Festo* were not supported by this Court's decision in *Exhibit Supply* – when in fact it is – this position would still not reflect reality. The suggestion that patent applicants consciously claim less than they feel they are entitled to, relying on the doctrine of equivalents, is nonsense. Moreover, doctrine of equivalents law has evolved and changed significantly through the years (including the rules set forth in this Court's decision in *Warner-Jenkinson*), so any notion of settled, vested rights in particulars of that doctrine never legitimately existed. This is especially true given the clear conclusion of this Court in *Exhibit Supply* that an applicant abandons "all that is embraced in [the] difference" between the original claim language and the narrowed claim language. *Exhibit Supply*, 315 U.S. at 136.

### 2. The Proposed "Unforeseeabilty" Exception To The *Festo* Rule Is Not Worth Its Substantial Cost

#### a. Only Infrequently Will An Amendment Covering Equivalents Be Unforeseeable

The United States and the I.E.E.E. both conclude that, where claim language is foreseeable at the time of a narrowing amendment at the point of disputed patentability, but such language goes unused by the applicant, the applicant should not be permitted to rely on the doctrine of equivalents to capture such unclaimed subject



matter after patent issuance. *See* U.S. Brief at 24; I.E.E.E. Brief at 23.

In fact, in only a fraction of the cases will language that would capture an accused device have been truly unforeseeable at the time of amendment. This is particularly true because such amendments are usually crafted years after the invention is made, and at a time when the technology selected by potential infringers is increasingly visible. Of course, if the technology sought to be covered by the amendment is well-known when the amendment is made, that diminishes any chance of showing that an amendment was unforeseeable.[9]

This leaves the less frequent situation of after-arising technology. Properly analyzed, the issue is not whether after-arising technology was foreseeable, but whether claim language that could encompass that technology was foreseeable. However, it is generally possible to use a broad array of claim techniques to claim "after-arising" technology. Indeed, a central mission of patent prosecution is to devise language that will both encompass future developments that incorporate the patented invention, and avoid unnecessary limitations. *See* ROBERT C. FABER,

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[9] The United States apparently holds open the possibility of including an "after-arising technology" exception to the *Festo* rule, in addition to the foreseeability exception. However, if claim language is foreseeable, the fact that the accused infringer has innovated should not justify an additional exception to the *Festo* rule. Nevertheless, the presence of after-arising technology may in some cases make it easier to prove the unforeseeability of the amendment. Accordingly, it is not clear why the United States proposed these as two different exceptions.

LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING X-2 (4th ed. 2000) (noting that the drafter must write claims that "cover competitive products which neither the inventor nor the attorney thought of or could even have imagined at the time, but which employ the concept of the invention."). Examples of the form of such language include the following: (1) generic language, such as "light source" instead of "lamp" if light is what is required for the invention, (2) terms of degree such as "mostly," (3) broadening modifiers such as "substantially" or "essentially," (4) functional limitations such as those expressly authorized under 35 U.S.C. Section 112(6), (5) negative limitations such as "but not . . . ", and (6) language of result such as "wherein the . . . ." *See, e.g.*, MANUAL OF PATENT EXAMINING PROCEDURE § 2173.05(b) (7th ed. 1998) (discussing acceptable uses in claims of "relative terminology" such as "about", "essentially" and "substantially"); ALAN M. HALE, PATENTING MANUAL 72 (2d ed. 1983) ("a claim is made broader by using generic names"). Thus, in most cases, claim language can cover after-arising technology so long as it is consistent with the patentability of the claimed invention.

In sum, it is the standard protocol of patent attorneys to avoid limitations that are unnecessary and to draft claims that fully cover the concept of the invention, rather than merely narrow embodiments of that invention. This responsibility should be, and is generally, heightened when the patent attorney is selecting narrowing language at the point of disputed patentability in the face of a Patent Office rejection. Accordingly, only in a relatively few cases will an amendment covering equivalents be truly unforeseeable to competent patent counsel.



### b. The Benefits Of A Foreseeability Test Are Not Worth Its Substantial Cost

As demonstrated above, there will be relatively few cases where subject matter excluded by an amendment at a point of disputed patentability could not have foreseeably been captured at the time of the amendment. The cost and difficulty of litigating this issue in virtually every case of prosecution history estoppel cannot be justified by those limited situations.

A foreseeability exception would be a difficult issue to litigate, depending on what the ground rules are. Some thorny questions are: (1) Is the foreseeability measured through the eyes of a technologist or a patent attorney or agent? Since the patent attorney or agent is normally the person who crafts claim language and is the person trained to maximize the scope of the claim as appropriate, it would add even more artificiality to the proposed legal test to analyze the question from the perspective of one skilled in the relevant technical art. However, to add yet another hypothetical actor in the world of patent law (e.g., a person of ordinary skill in the art of claim drafting in the relevant technical art) would appear, at first blush, to be no more appetizing. (2) To what extent are the particular circumstances of the particular patent prosecution taken into account in determining foreseeability? Because objective analyses are performed in the context of the facts of the case at hand, some actual facts would need to be considered. For example, would the hypothetical person be assumed to know the entire state of the technical art, as is the hypothetical person in the obviousness analysis, or would they know only the technical art

of record in the Patent Office? Would they instead be presumed to know all technical art of which they can be shown to have been actually aware, or all technical art of which they knew or should have known? Creating and applying such rules will not be easy. **(3)** What needs to be foreseeable, the technology uncaptured by the claim language or the potential claim language that would cover that technology? It is one thing to analyze whether the claim could foreseeably have been drafted to encompass after-arising technology, for example, by using the standard patent attorney tool kit of claiming techniques described above at page 22. It is another to measure whether the after-arising technology in the context of the claimed invention could have been foreseen. It is yet another matter to evaluate whether the after-arising technology could have been foreseen at all. **(4)** Does the after-arising technology have to be non-obviously different from existing technology? A natural patent litigation test to determine whether technology is "after-arising" at all is whether the technology would have been non-obvious (*see* 35 U.S.C. § 103). Borrowing this test would be convenient, but would add substantial complexity to the case. **(5)** How does one determine whether potentially foreseeable claim language would have been granted in view of the patentability rejection in the Patent Office, if that matters? Does a patentability test need to be performed on the potentially foreseeable language to determine if the claim would have issued from the Patent Office from the perspective of an examiner, or would it be performed as though the claim had issued with a presumption of



validity? **(6)** What is the general standard for foreseeability? Does it borrow the well-established, but elaborate concepts of novelty and non-obviousness developed elsewhere in patent law? *See* 35 U.S.C. §§ 102, 103.

The evidence submitted on these issues could be voluminous and complicated to evaluate. Moreover, the legal rules that develop may well turn out to be difficult to apply in many cases.

Litigating the foreseeability issue would be particularly expensive – even beyond the normal cost of addressing such potentially complicated issues. The value of the *Festo* rule is that businesses are in a much better position to pursue safely a very expensive product development program without fear that the resultant product could be shut down after a costly trial and sales to now-orphaned customers. Because prosecution history estoppel is a question of law, *see Warner-Jenkinson*, 520 U.S. at 39 n.8, claims that are barred by that doctrine are resolved reliably on summary judgment under *Festo*. The foreseeability exception, if adopted, would therefore become yet another breeding ground of uncertainty in such a case for both sides. Simply put, patent litigation is expensive and unpredictable enough for all parties without forcing the litigation of this proposed exception, which should properly only apply in a relatively few cases anyway.

While the foreseeability issue may have equitable appeal as an abstract concept, as a practical matter it simply is not worth its considerable weight.

### B. All Narrowing Amendments Related To Patentability Should Give Rise To A Prosecution History Estoppel

The Federal Circuit, with little dissent (one judge out of twelve), concluded that all narrowing amendments related to the statutory requirement of patentability give rise to prosecution history estoppel. This unexceptional ruling is based on substantial precedent and should be affirmed. *See Warner-Jenkinson*, 520 U.S. at 40-41 (if an amendment "had a purpose *unrelated* to patentability, a court must consider that purpose in order to decide whether an estoppel is precluded.") (emphasis supplied).

Petitioner appears to acknowledge that the touchstone of whether a prosecution history estoppel arises is, and should be, whether a narrowing amendment is made for reasons of patentability. *See* Pet. Brief at 26. Accordingly, Petitioner argues that the Federal Circuit's interpretation is flawed simply because it construes the term "patentability" too broadly. *Id.* ("To the contrary, 'patentability' has an established and limited meaning."). Petitioner's chief argument is that the term "patentability," for purposes of an estoppel analysis, is controlled by the words chosen for the names of the chapters in Title 35. *Id.* Specifically, Petitioner argues that only amendments in response to objections based on the provisions of Chapter 10 of Title 35 can create an estoppel because that Chapter is entitled "Patentability Of Inventions." *Id.* Thus, Petitioner argues that narrowing amendments in response to rejections based on provisions of other chapters, such as Section 112 of Title 35, cannot create an estoppel. *Id.* ("Section 112 is in the chapter describing the



'Application For Patent.' "). This argument dangerously elevates semantics over substance.

It is well-established that the adequacy of disclosure is a fundamental aspect of patentability. *See, e.g., Gould v. Mossinghoff*, 711 F.2d 396, 397 n.2 (D.C. Cir. 1983) ("Patent applicants must disclose information specified by 35 U.S.C. § 112 to obtain a patent."); *see also Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944) (commenting that the "*quid pro quo*" for receiving a patent is "disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention . . . and the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted.").

Section 112 requires, for example, that a patent applicant enable the full scope of a claimed invention. *See Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997) ("to be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention"). It is common during patent prosecution for the Patent Office to reject claims because the patent specification does not enable the full scope of the broad claims that are submitted. To take a common situation, if an applicant submits a specification which contains one example, but attempts to encompass thousands of examples in the claim it seeks, the Patent Office may reject that claim under Section 112(1). Specifically, the Patent Office may reject the claim because, on the facts presented, the full scope of the claim is not enabled. For instance, the specification may only teach how to make and use limited aspects of the broadly claimed subject matter. If claim language is added in

response to such a rejection to narrow the claim to the one disclosed example which is taught, one can readily see that the prosecution history estoppel issues are not meaningfully different than when an applicant narrows a claim in response to a rejection based on prior art. Precisely how broad or narrow the claims should be in view of the teachings of the specification is something that should be resolved when the Patent Office rejects the application, and the applicant is crafting an amendment to attempt to obtain a patent. An applicant should not be permitted to simply add narrowing language to avoid a Section 112 rejection to obtain a patent, while unfairly leaving the critical question of the appropriate scope of the claims in view of the submitted disclosure to await litigation.

In short, Petitioner's argument based on the chapter names in Title 35 ignores, among other things, the fact that Section 112 unquestionably sets forth important rules of patentability. There is no good reason why narrowing amendments to obtain a patent over a rejection based on such patentability concerns should not give rise to a prosecution history estoppel. Petitioner's argument based



on the chapter designations is simply too superficial and should be rejected.

Respectfully submitted,

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